

## **II. REMARKS**

### ***Claim Status***

Claims 1, 2, 5-7, 9-11 and 16-22 are presently pending in the instant application.

### ***Claim Rejections - 35 USC § 103***

Claims 1-2, 5, 7, 9-11, 17-20, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Uhlmann et al. in view of Norton et al. (1996) and Mata et al., for the reasons of record.

Applicant's arguments have been fully considered but they are not persuasive.

Applicants traversed the instant rejection in their response filed 6-17-07 on the following grounds:

"With regard to the failure of the references to disclose the presence of a terminal primary amino group in the PNA oligomeric chimeras, the examiner states that the terminal secondary amino group in the compounds of Uhlmann et al. can readily be converted to a primary amino group. This may well be but the reference does not disclose such step, nor does it indicate the importance of such cleavage to a primary amine."

The examiner notes that Applicants do not provide any evidence that the ordinary skilled artisan would not be motivated to combine the teachings of Uhlmann et al., Norton et al., and Mata et al. in the design of the claimed invention. The examiner further notes that although arguments of counsel may be

effective in establishing that an examiner has not properly met his or her burden or has otherwise erred in his or her position, the examiner emphasized that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure.

The examiner provided a citation to a case where the record consisted substantially of arguments and opinions of applicant's attorney, and the court indicated that factual affidavits could have provided important evidence on the issue of enablement.

Applicant's are herein responding to the examiner by providing the Declaration of Eckart Matthes demonstrating that it would not have been obvious, for the reasons therein stated for one skilled in the art to combine the teachings of Uhlmann et al. in view of Norton et al. (1996) and Mata et al. and arrive at applicant's invention.

Applicants believe they have not met their burden of providing evidence supporting their position that the instant claims are not obvious over the combination of references cited by the examiner.

Based on the foregoing remarks it is believed that the claims are in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved. If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge any insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By / Serle Ian Mosoff/

Serle Ian Mosoff

Attorney for Applicant(s)

Reg. No. 25,900

875 Third Avenue - 18<sup>th</sup> Floor

New York, New York 10022

Phone: (212) 808-0700

Fax: (212) 808-0844